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Federal Agencies

January 13, 2005

WRITER'S DIRECT NUMBER:

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Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Re: U.S. Utility Patent Application
Appl. No. 10/829,381; Filed: April 22, 2004
For: **Novel Fluorogenic or Fluorescent Reporter Molecules and Their
Applications for Whole-Cell Fluorescence Screening Assays for
Caspases and Other Enzymes and the Use Thereof**

Inventors: Weber *et al.*
Our Ref: 1735.0290006/RWE/ALS

Sir:

The following documents are forwarded herewith for appropriate action by the U.S. Patent and Trademark Office:

1. SKGF Cover Letter;
2. Information Disclosure Statement;
3. Thirty-four (34) pages of Form PTO-1449 citing one hundred sixty-two documents;
4. A copy of documents AN4, AS34 and AT34; and
5. One (1) return postcard.

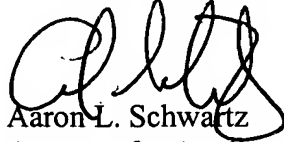
It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Commissioner for Patents
January 13, 2005
Page 2

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Aaron L. Schwartz
Attorney for Applicants
Registration No. 48,181

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ALS/law
Enclosures
353810v1



IFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Weber *et al.*

Appl. No.: 10/829,381

Filed: April 22, 2004

For: **Novel Fluorogenic or Fluorescent Reporter Molecules and Their Applications for Whole-Cell Fluorescence Screening Assays for Caspases and Other Enzymes and the Use Thereof**

Confirmation No.: 7746

Art Unit: 1642

Examiner: *To be assigned*

Atty. Docket: 1735.0290006/RWE/ALS

**Information Disclosure Statement
under 37 C.F.R. § 1.97(b)**

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98.

Copies of all documents, except documents AN4, AS34 and AT34, were cited by or submitted to the Office in an IDS that complies with 37 C.F.R. § 1.98(a)-(c) in Application No. 09/947,387, filed September 7, 2001, which is relied upon for an earlier filing date under 35 U.S.C. § 120. Thus, copies of these documents are not attached. 37 C.F.R. § 1.98(d). Copies of documents AN4, AS34 and AT34 are included.

Except as otherwise described in this pleading, where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed publication dates on the attached PTO-1449 based on information presently available to

the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants would like to bring to the Examiner's attention documents AT1, AR10 AS10 and AS13. Although the exact dates of these publications were not determined, the citations should not be construed as an admission that the information was actually published prior to October 10, 1996. Applicants would like to bring to the Examiner's attention document AS23. Although the exact date of this publication was not determined, the listed citation should not be construed as an admission that the information was actually published prior to October 9, 1997.

Document AO2 is in the German language with an English language abstract. The relevance of Document AO2 can be ascertained by reference to Document AS26, which is an unverified English language abstract thereof.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

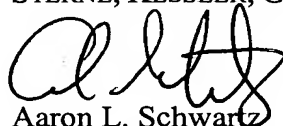
This Information Disclosure Statement is being filed before the mailing date of a first Office Action on the merits. No statement or fee is required.

It is respectfully requested that the Examiner initial and return a copy of the enclosed PTO-1449, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

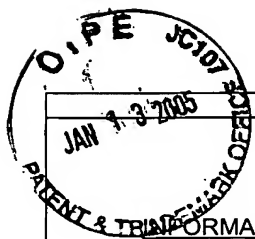
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to read 'A. Schwartz', is written over the printed name.

Aaron L. Schwartz
Attorney for Applicants
Registration No. 48,181

Date: January 13, 2005

1100 New York Avenue, N.W.
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FORM PTO-1449

INFORMATION DISCLOSURE STATEMENT

ATTY. DOCKET NO.
1735.0290006/RWE/ALSAPPLICATION NO.
10/829,381FIRST NAMED INVENTOR
Weber *et al.*FILING DATE
April 22, 2004ART UNIT
1642

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA1	4,044,126	08/23/1977	Cook <i>et al.</i>			
	AB1	4,336,186	06/22/1982	Gargiulo <i>et al.</i>			
	AC1	4,364,923	12/21/1982	Cook <i>et al.</i>			
	AD1	4,414,209	11/08/1983	Cook <i>et al.</i>			
	AE1	4,522,811	06/11/1985	Eppstein <i>et al.</i>			
	AF1	4,557,862	12/10/1985	Mangel <i>et al.</i>			
	AG1	4,640,893	02/03/1987	Mangel <i>et al.</i>			
	AH1	5,208,148	05/04/1993	Haugland <i>et al.</i>			
	AI1	5,227,487	07/13/1993	Haugland <i>et al.</i>			
	AJ1	5,362,628	11/08/1994	Haugland <i>et al.</i>			
	AK1	5,443,986	08/22/1995	Haughland <i>et al.</i>			

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL1	EP 0 285 179 B1	10/05/1988	Europe			Yes No
	AM1	EP 0 528 487 A2	02/24/1993	Europe			Yes No
	AN1	WO 93/04192	03/04/1993	WIPO			Yes No
	AO1	WO 93/10461	05/27/1993	WIPO			Yes No
	AP1	WO 94/06906	03/31/1994	WIPO			Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	1	Adams, S.R., <i>et al.</i> , "Biologically Useful Chelators That Take Up Ca ²⁺ upon Illumination," <i>J. Am. Chem. Soc.</i> 111:7957-7968, American Chemical Society (1989)
	AS	1	Alder, A., <i>et al.</i> , "Optical sensor for the determination of cations, its use, and fluorophores therefor," <i>Chemical Abstracts</i> 123:114, The American Chemical Society, Abstract No. 35266b (1995)
	AT	1	Alnemri, E.S., <i>et al.</i> , "Human ICE/CED-3 Protease Nomenclature," <i>Cell</i> 87:171, Cell Press (October 1996)

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

FORM PTO-1449 INFORMATION DISCLOSURE STATEMENT	ATTY. DOCKET NO. 1735.0290006/RWE/ALS	APPLICATION NO. 10/829,381
	FIRST NAMED INVENTOR Weber <i>et al.</i>	
	FILING DATE April 22, 2004	ART UNIT 1642

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA2	5,556,992	09/17/1996	Gaboury <i>et al.</i>			
	AB2	5,576,424	11/19/1996	Mao <i>et al.</i>			
	AC2	5,587,490	12/24/1996	Goodrich, Jr., <i>et al.</i>			
	AD2	5,605,809	02/25/1997	Komoriya <i>et al.</i>			
	AE2	5,698,411	12/16/1997	Lucas <i>et al.</i>			
	AF2	5,714,342	02/03/1998	Komoriya <i>et al.</i>			
	AG2	5,733,719	03/31/1998	Jaffe <i>et al.</i>			
	AH2	5,773,236	06/30/1998	Diwu <i>et al.</i>			
	AI2	5,776,720	07/07/1998	Jaffe <i>et al.</i>			
	AJ2	5,834,216	11/10/1998	Roizman <i>et al.</i>			
	AK2	5,843,635	12/01/1998	Schlossman <i>et al.</i>			

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL2	CA 2,119,840	09/27/1994	Canada			Yes No
	AM2	WO 96/20721	07/11/1996	WIPO			Yes No
	AN2	WO 96/36729	11/21/1996	WIPO			Yes No
	AO2	WO 98/13517	04/02/1998	WIPO			Yes X No
	AP2	WO 98/55863	12/10/1998	WIPO			Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	2	An, S., and Knox, K.A., "Ligation of CD40 rescues Ramos-Burkitt lymphoma B cells from calcium ionophore- and antigen receptor-triggered apoptosis by inhibiting activation of the cysteine protease CPP32/Yama and cleavage of its substrate PARP," <i>FEBS Lett.</i> 386:115-122, Federation of European Biochemical Societies (May 1996)
	AS	2	Armstrong, R.C., <i>et al.</i> , "Fas-induced Activation of the Cell Death-related Protease CPP32 Is Inhibited by Bcl-2 and by ICE Family Protease Inhibitors," <i>J. Biol. Chem.</i> 271:16850-16855, The American Society for Biochemistry and Molecular Biology, Inc. (July 1996)
	AT	2	Assfalg-Machleidt, I., <i>et al.</i> , "Membrane Permeable Fluorogenic Rhodamine Substrates for Selective Determination of Cathepsin L," <i>Biol. Chem. Hoppe-Seyler</i> 373:433-440, Walter de Gruyter & Co. (1992)

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FORM PTO-1449 INFORMATION DISCLOSURE STATEMENT	ATTY. DOCKET NO. 1735.0290006/RWE/ALS	APPLICATION NO. 10/829,381
	FIRST NAMED INVENTOR Weber <i>et al.</i>	
	FILING DATE April 22, 2004	ART UNIT 1642

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA3	5,849,513	12/15/1998	Jaffe <i>et al.</i>			
	AB3	5,871,946	02/16/1999	Lucas <i>et al.</i>			
	AC3	5,897,992	04/27/1999	Fearnhead <i>et al.</i>			
	AD3	5,908,750	06/01/1999	Reed <i>et al.</i>			
	AE3	5,976,822	11/02/1999	Landrum <i>et al.</i>			
	AF3	6,037,137	03/14/2000	Komoriya <i>et al.</i>			
	AG3	6,048,703	04/11/2000	Siman <i>et al.</i>			
	AH3	6,075,020	06/13/2000	Cincotta <i>et al.</i>			
	AI3	6,077,684	06/20/2000	Kravtsov			
	AJ3	6,200,969 B1	03/13/2001	Fritz <i>et al.</i>			
	AK3	6,251,614 B1	06/26/2001	Fritz <i>et al.</i>			

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL3	WO 98/57664	12/23/1998	WIPO			Yes No
	AM3	WO 99/18856	04/22/1999	WIPO			Yes No
	AN3	WO 00/04914	02/03/2000	WIPO			Yes No
	AO3	WO 00/07017	02/10/2000	WIPO			Yes No
	AP3	WO 00/45165	08/03/2000	WIPO			Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>3</u>	Bonneau, P.R., <i>et al.</i> , "Design of Fluorogenic Peptide Substrates for Human Cytomegalovirus Protease Based on Structure-Activity Relationship Studies," <i>Analyt. Biochem.</i> 255:59-65, Academic Press (January 1998)
	AS	<u>3</u>	Calabresi, P., and Chabner, B.A., "Chemotherapy of Neoplastic Diseases," in <i>Goodman & Gilman's The Pharmacological Basis of Therapeutics. Ninth Edition</i> , The McGraw-Hill Companies, pp. 1225-1287 (January 1996)
	AT	<u>3</u>	di Giovine, F.S., and Duff, G.W., "Interleukin 1: the first interleukin," <i>Immunol. Today</i> 11:13-20, Elsevier Science Publishers (UK) Ltd. (1990)

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U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA4	6,248,904 B1	06/19/2001	Zhang <i>et al.</i>			
	AB4	6,270,980 B1	08/07/2001	Fritz <i>et al.</i>			
	AC4	6,335,429 B1	01/01/2002	Cai <i>et al.</i>			
	AD4	6,342,611 B1	01/29/2002	Weber <i>et al.</i>			
	AE4	2002/0076733 A1	06/20/2002	Kasibhatla <i>et al.</i>			
	AF4	6,462,041 B1	10/08/2002	Cai <i>et al.</i>			
	AG4	2003/0027229 A1	02/06/2003	Kasibhatla <i>et al.</i>			
	AH4	2003/0208037 A1	11/06/2003	Zhang <i>et al.</i>			
	AI4	6,518,032	02/11/2003	Fritz <i>et al.</i>			
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FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL4	WO 01/79187	10/25/2001	WIPO			Yes No
	AM4	WO 02/12545	02/14/2002	WIPO			Yes No
	AN4	WO 96/33209	10/24/1996	WIPO			Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	4	Dilanni, C.L., <i>et al.</i> , "In Vitro Activity of the Herpes Simplex Virus Type 1 Protease with Peptide Substrates," <i>J. Biol. Chem.</i> 268:25449-25454, The American Society for Biochemistry and Molecular Biology, Inc. (1993)
	AS	4	Dinareello, C.A., "Interleukin-1 and Interleukin-1 Antagonism," <i>Blood</i> 77:1627-1652, W. B. Saunders Company (1991)
	AT	4	Ding, J., <i>et al.</i> , "Crystal structure of the human adenovirus proteinase with its 11 amino acid cofactor," <i>EMBO J.</i> 15:1778-1783, IRL Press Limited (April 1996)

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	AL						Yes No
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	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>5</u>	Diouri, M., <i>et al.</i> , "Cleavage Efficiency by Adenovirus Protease Is Site-dependent," <i>J. Biol. Chem.</i> 271:32511-32514, The American Society for Biochemistry and Molecular Biology, Inc. (December 1996)
	AS	<u>5</u>	Evans, D.B., <i>et al.</i> , "An Ultrasensitive Human Immunodeficiency Virus Type 1 Protease Radioimmuno Rate Assay with a Potential for Monitoring Blood Levels of Protease Inhibitors in Acquired Immunodeficiency Disease Syndrome Patients," <i>Analyt. Biochem.</i> 206:288-292, Academic Press, Inc. (1992)
	AT	<u>5</u>	Evan, G., and Littlewood, T., "A Matter of Life and Cell Death," <i>Science</i> 281:1317-1322, American Association for the Advancement of Science (August 1998)

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	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>6</u>	Friesen, C., <i>et al.</i> , "Involvement of the CD95 (APO-1/Fas) receptor/ligand system in drug-induced apoptosis in leukemia cells," <i>Nature Med.</i> 2:574-577, Nature Publishing Group (May 1996)
	AS	<u>6</u>	Fulda, S. <i>et al.</i> , "Betulinic Acid Triggers CD95 (APO-1/Fas)- and p53-independent Apoptosis via Activation of Caspases in Neuroectodermal Tumors," <i>Cancer Res.</i> 57:4956-4964, American Association of Cancer Research (November 1997)
	AT	<u>6</u>	Gamen, S. <i>et al.</i> , "Doxorubicin-induced apoptosis in human T-cell leukemia is mediated by caspase-3 activation in a Fas-independent way," <i>FEBS Lett.</i> 417:360-364, Elsevier Science Publishers B.V. (November 1997)

EXAMINER	DATE CONSIDERED
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	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>1</u>	Ganesh, S., <i>et al.</i> , "Flow Cytometric Determination of Aminopeptidase Activities in Viable Cells Using Fluorogenic Rhodamine 110 Substrates," <i>Cytometry</i> 20:334-340, Wiley-Liss, Inc. (1995)
	AS	<u>1</u>	Gallop, M.A., <i>et al.</i> , "Applications of Combinatorial Technologies to Drug Discovery. 1. Background and Peptide Combinatorial Libraries," <i>J. Med. Chem.</i> 37:1233-1251, American Chemical Society (1994)
	AT	<u>1</u>	Gao, M., <i>et al.</i> , "The Protease of Herpes Simplex Virus Type 1 Is Essential for Functional Capsid Formation and Viral Growth," <i>J. Virol.</i> 68:3702-3712, American Society for Microbiology (1994)

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	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>8</u>	Gordon, E.M., <i>et al.</i> , "Applications of Combinatorial Technologies to Drug Discovery. 2. Combinatorial Organic Synthesis, Library Screening Strategies, and Future Directions," <i>J. Med. Chem.</i> 37:1385-1401, American Chemical Society (1994)
	AS	<u>8</u>	Greene, T.W. and Wuts, P.G.M., "Protection For The Amino Group," in <i>Protective Groups in Organic Synthesis</i> , Greene, T.W. and P.G.M. Wuts, Eds., John Wiley and Sons, Inc., New York, NY, pp. 309-315 (1980)
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	FIRST NAMED INVENTOR Weber <i>et al.</i>	
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AR	<u>31</u>	Mooberry, S.L., <i>et al.</i> , "Laulimalide and Isolaulimalide, New Paclitaxel-Like Microtubule-Stabilizing Agents," <i>Canc. Res.</i> 59:653-660, American Society for Cancer Research (February 1999)
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